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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,637

03/24/2004

Moosa Eisa Al Amri

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08/26/2004

STURM & FIX LLP

206 SIXTH AVENUE

SUITE 1213

DES MOINES, IA 50309-4076

EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

45

Office Action Summary	Application No.	Applicant(s)	
	10/807,637	AL AMRI, MOOSA EISA	
	Examiner	Art Unit	
	Allyson N Trail	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/24/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/24/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1, 2, and 6-8 are objected to because of the following informalities:

Re claim 1, line 2: replace "its front" with --the smart document's front--.

Re claim 2, line 2: replace "its attached" with --the smart document's attached--.

Re claim 2, line 2: replace "its long direction" with --the thick card portion's long direction--.

Re claim 6, line 2: replace "its edges" with --the smart document's edges--.

Re claims 6 and 7, line 2: replace "its first" with --the smart document's first--.

Re claim 8, line 2: replace "its second" with --the smart document's second--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before

Art Unit: 2876

the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5-11, 13-16, 18-20, and 24-35 are rejected under 35

U.S.C. 102(e) as being anticipated by Blank (2003/0150919).

Blank teaches the following in regards to claims 1 and 6-8:

Figures 1-5 show a smart document 1. The smart document 1 (figures 1-5) comprises a thin portion 20 (figures 1-5) carrying visible data 30 (figure 3) and a thick portion 10 (figures 1-5). The thick portion includes a magnetic strip 13 (figure 2). Figure 3 shows the thick portion being attached to an edge of the thin portion in a manner allowing inclination of the thick card portion relative to the thin portion. Figure 3 also shows the thick card portion being divided into first and second parts on either side of the attachment to the edge of the thin portion. The thick card portion is inclinable between a flat position and an inclined position.

Blank teaches the following in regards to claim 2:

Blank's figures show the smart document in various sizes and shapes. It is clear that any configuration, which includes a thick and thin portion, may be possible according to Blank's disclosure. Figure 1 shows the thin and thick portion being oblong. Figure 2 shows the thin and thick portions being substantially equal in dimension.

Blank teaches the following in regards to claim 3:

Figure 1 shows the thick portion being rectangular with rounded edges.

Blank teaches the following in regards to claims 4 and 5:

Blank shows in figure 3, the first part of the thick card portion is smaller than the second part. As explained above, Blank's figures show the smart document in various sizes and shapes. It is clear that any configuration, which includes a thick and thin portion, may be possible according to Blank's disclosure.

Blank teaches the following in regards to claims 9 and 10:

"The transaction card 10 and the auxiliary portion 20 may be formed of any suitable material, such as a plastic or paper sheet material." (Page 3, paragraph 0034).

"In an alternative embodiment (and equally applicable to all embodiments herein), the transaction card 10 and the auxiliary portion 20 may be formed separately, and may be formed of different materials. The transaction card 10 and the auxiliary portion 20 may then be connected together, e.g., along mating edges positioned similar to that shown for the line of weakness 2 in FIGS. 1 and 2." (Page 3, paragraph 0036).

Blank teaches the following in regards to claim 11:

Figure 1 shows the thin portion being generally rectangular.

Blank teaches the following in regards to claims 13 and 14:

"The transaction card 10 and the auxiliary portion 20 may be joined together at the edges by any suitable means, such as thermal welding, an adhesive, a mechanical fastener, a coupling device (e.g., a coupling having opposed channels into which the edges of the transaction card 10 and the

Art Unit: 2876

auxiliary portion 20 are inserted and held by the channels) and so on.” (Page 3, paragraph 0036).

Blank teaches the following in regards to claim 15:

“If the transaction card 10 is intended to meet ANSI and ISO specifications, at least the transaction card 10 may be made from a sheet of suitable material, e.g., poly vinyl chloride (PVC) or other material (e.g., PET, PETG, ABS or other plastic and/or synthetic materials) having a thickness of 0.030 inches. \pm .ten percent. However, ANSI and ISO specifications for transaction cards typically change over time, and therefore the transaction card 10 may be made of any suitable material, have any suitable dimensions or have any other feature to meet with desired ANSI and ISO specifications for transaction cards.” (Page 3, paragraph 0034).

Blank teaches the following in regards to claim 16:

Figure 2 shows the magnetized strip located adjacent a long edge of the smart document.

Blank teaches the following in regards to claims 18, 29, and 30:

“The transaction card portion 10 may be formed to fall within the standard CR-80 footprint, e.g., so the card may be used with standard throat-type card readers.” (Page 3, paragraph 0035). Blank’s transaction card is able to be passed through a reader before or after the thin portion has been detached.

Blank teaches the following in regards to claims 19 and 20:

Art Unit: 2876

The magnetic strip is encoded and therefore contains an image of an identification means, including a personal identification, which acts as a signature.

Blank teaches the following in regards to claims 24, 26, 27, 31, 33, 34, and 35:

“As with any of the embodiments described herein, the transaction card portion 10 may be used, for example, as a credit or debit card, a membership identification card, an account identification card, a gift card, a prepaid telephone card, and so on.” (Page 3, paragraph 0035).

Blank teaches the following in regards to claims 25 and 32:

“The transaction card portion 10 may be a hotel room key (as are commonly known) or a gift card for a shoe store, for example.” (Page 5, paragraph 0046).

Blank teaches the following in regards to claim 28:

It is discussed in paragraph 0046, that one portion may correspond to the other portion. The example given is the first portion is a shoe horn and the transaction card is a gift card to a shoe store. The magnetic data encoded would have information regarding the shoe store.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 2876

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blank (2003/0150919) in view of Ovadia (5,612,527).

Blank's teachings are discussed above. Blank fails to teach the thin portion including a perforated section remote from the edge to which the thick card portion is attached.

Regarding claim 12, Ovadia teaches figure 2. This figure shows a brochure including a perforated section.

In view of Ovadia's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Blank's smart document and include an additional perforated section attached to the thin portion. Blank teaches the thin portion to be used for various functions, such as an advertisement to be used along with a gift card (transaction card 10). One function of the thin portion could easily be a brochure, which corresponds with the transaction card. One would be motivated to include (on the thin portion) a perforated section for the purpose of a coupon that would also correspond with the transaction card and the advertisement printed on the thin portion.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blank (2003/0150919) in view of Lasch et al (6,764,014).

Blank's teachings are discussed above. Blank fails to specifically teach the transaction card including a storage chip.

Regarding claim 17, Lasch et al teaches figure 1. This figure shows a storage chip 20 included on the transaction card 5.

Art Unit: 2876

In view of Lasch et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to include on Blank's smart document a storage chip. Blank teaches the transaction card to include a magnetic strip. One would be motivated to further include a storage chip to increase the storage capacity on the transaction card. A chip as opposed to a magnetic strip is able to include a memory, which may store more user identification information or card specification information. Including both a magnetic strip and a storage chip is ideal for a versatile transaction card, which may be read via a standard card reader as well as a contactless reader.

8. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank (2003/0150919).

Blank's teachings are discussed above. Blank however fails to teach more than one thick portion attached to different parts of the thin portion.

In view of Blank's teachings however it is obvious to one of ordinary skill in the art to include multiple thick portions at various parts of the thin portions. As explained above, Blank's figures show the smart document in various sizes and shapes. It is clear that any configuration, which includes a thick and thin portion, may be possible according to Blank's disclosure. Additionally, Blank teaches the smart document to be used for a room key in a hotel. One would be motivated to attach multiple thick portions (room keys) to one thin portion. This would benefit a family or more than one person who each would desire to have a room key.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Blank (6,588,658), Hass (6,513,710), Rivera (5,686,713), Hill et al (2004/0089706), Warther et al (6,769,718), Weirather et al (2003/0150550), and Gerner et al (3,912,082).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

Art Unit: 2876

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
August 23, 2004

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER